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| APPLICATION NO.  | FILING DATE  | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|--------------|----------------------|---------------------|------------------|
| 09/901,210   | 07/09/2001   | Royce J. Bowles JR.  | 17342-0011          | 6398             |
| 29052  | 7590         | 09/08/2003           |                     | 9                |
| SUTHERLAND ASBILL & BRENNAN LLP<br>999 PEACHTREE STREET, N.E.<br>ATLANTA, GA 30309 |              |                      | EXAMINER            |                  |
|  |              |                      | LORENZO, JERRY A    |                  |
| ART UNIT   | PAPER NUMBER |                      |                     |                  |
| 1734   |              |                      |                     |                  |

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application N .</b> | <b>Applicant(s)</b> |
|                              | 09/901,210             | BOWLES ET AL.       |
|                              | <b>Examin r</b>        | <b>Art Unit</b>     |
|                              | Jerry A. Lorengo       | 1734                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

## DETAILED ACTION

(1)

### *Claim Rejections - 35 USC § 103*

The rejection of claims 1, 7, 8, 10 and 13 under 35 U.S.C. 103(a) as being unpatentable over EP 913440 A1 to Otaki et al. in view of JP 03-63199 to Nakanishi, as generally set forth in the office action mailed March 7, 2003, stands.

(2)

The rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (1), above, in further view of U.S. Patent No. 4,436,571 to Nakanishi, as generally set forth in the office action mailed March 7, 2003, stands.

(3)

The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (1), above, in further view of U.S. Patent No. 4,231,829 to Marui et al., as generally set forth in the office action mailed March 7, 2003, stands.

(4)

The rejection of claims 2-6 and 12 under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (2), in further view of U.S. Patent No. 5,695,587 to Dumoux, as generally set forth in the office action mailed March 7, 2003, stands.

(5)

### *Response to Amendments and Arguments*

The amendments and arguments filed June 30, 2003 are acknowledged. The cancellation of non-elected claims 14-26 is likewise acknowledged.

Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive.

The instant invention is generally drawn to the formation of a imaged soluble transfer film which is then floated upon a bath of liquid and then transferred via the surface tension of the liquid to an object pressed against the floating film. Both the Otaki et al. and Nakanishi references are drawn to methods for the transfer solvent-based ink images from a water-soluble film onto an article surface by way of float transfer.

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As pointed out by the applicant, Otaki et al. utilizes colored liquid inks to image the transfer sheet while Nakanishi utilizes digitally driven xerography to provide a multicolored image to the transfer sheet. Based on this difference, the applicant main argument contends that there is no motivation to combine the four-color process printing of the Otaki reference with the digital imaging process of Nakanishi to arrive at the instant invention. The examiner respectfully disagrees.

As explained in the office action mailed March 7, 2003:

Although Otaki et al. disclose . . . that the solvent based ink image is printed by rotogravure printing on a water-soluble PVA film and placed on the surface of a water bath such that the ink image is facing away from the surface of the water, they do not specifically disclose . . . that the solvent-based ink image is provided by way of a digital image file.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the printed ink image by way of a digital image file motivated by the fact that Nakanishi, also drawn to methods for the transfer solvent-based ink images from a water-soluble film onto an article surface by way of float transfer, discloses that image making up the printed image can be composed manually or digitally through the use of a computer.

From the above explanation, the examiner respectfully submits that there is adequate motivation to combine the reference because they are both drawn to the same process and differ only in their printing methods. The examiner respectfully submits that the skilled artisan would have appreciated that the four-color solvent based inks of Otaki et al. could be printed digitally, as suggested by Nakanishi, using a four-color process given the fact that many ink-jet printers (a digitally driven printing method) are capable of printing solvent based liquid inks in four colors, i.e., K(black), C(cyan), M(magenta), and Y(yellow). Therefore, the examiner respectfully submits that the references were combined with proper motivation and, as such, the rejections set forth in sections (1) through (4) are FINAL.

(6)

#### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(7)

Applicant is encouraged to **FAX After Final Amendments** (37 CFR 1.116) to expedite delivery to the Examiner. The Group 1734 Facsimile number is **(703) 872-9311**. A duplicate mailed copy of the facsimile transmission is **not required** and will only serve to delay the processing of your application.

If the applicant prefers to mail in After Final correspondence it is highly recommended that such be mailed to **BOX AF** which will also facilitate processing from the mailroom and within Group 1700.

(8)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorendo whose telephone number is **(703) 306-9172**. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on **(703) 308-3853**. The fax phone numbers for the organization where this application or proceeding is assigned are **(703) 305-7115** for regular communications and **(703) 872-9311** for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 308-0661**.

J.A. Lorendo  
Primary Examiner  
AU 1734  
September 5, 2003